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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Art Unit: 1647  
                          ) )  
NIELSEN, et al.       ) Examiner: DEBERRY, REGINA  
                          ) )  
Serial No.: 09/845,716 ) Washington, D.C.  
                          ) )  
Filed: May 2, 2001     ) April 26, 2004  
                          ) )  
For: USE OF  $\alpha$ -MSH AND EPO FOR ) Docket No.: NIELSEN=3A  
PREVENTING OR TREATING   ) )  
ISCHEMIC CONDITIONS     ) Confirmation No.: 3819

PETITION TO VACATE RESTRICTION REQUIREMENT  
AND SUBSEQUENT OFFICE ACTION

U.S. Patent and Trademark Office  
2011 South Clark Place  
Customer Window, Mail Stop Petition  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, Virginia 22202

S i r :

Applicants hereby petition the Commissioner under 37 CFR 1.182 to exercise supervisory authority and vacate (1) the restriction requirement mailed October 2, 2003 and (2) the action on the merits mailed February 25, 2004. It is believed that this is a "no-fee" petition, but if we are mistaken, the petition fee should be charged to Deposit Account 02-4035.

1. The October 2, 2003 restriction is defective because it failed to consider original composition claim 11:

A pharmaceutical composition comprising a combination of  $\alpha$ -MSH or and/or  $\alpha$ -MSH equivalent and EPO and/or an EPO equivalent together with a pharmaceutically acceptable carrier.

While the restriction appears to consider claim 11, that is a false impression. Eleven claims were originally filed. On September 24, 2001, Applicants filed an amendment which, inter alia, added six claims. These claims were erroneously numbered 11-16 (they should have been 12-17). Thus, there were two claims numbered "11".

It is evident that the restriction overlooked the numbering error, since it refers only to claims up to 16. Which claim 11, then, did it examine? Plainly, method claim "11", which should have been numbered 12, because the restriction defines groups I-IV as directed just to "methods". (Indeed, the Examiner subsequently confirmed by telephone that composition claim 11 was not examined for restriction purposes.) The failure to examine composition claim 11 for restriction purposes renders the October 2, 2003 restriction incomplete, and hence it must be vacated.

Counsel became aware of the misnumbering in the course of preparing the December 2, 2003 response to the restriction requirement, and called it to the Examiner's attention in that response.

2. The office action mailed February 25, 2004 acknowledged that 11-16 had to be renumbered 12-17, as there was already a claim 11 originally filed. However, the action is defective because it treats composition claim 11 as withdrawn from consideration, even though the Examiner knew it was never examined for restriction purposes.

3. The February 25, 2004 office action is also defective because it imposes species choices sua sponte. The October 2, 2003 restriction had said that each of claims 2, 13, 14, 15 (i.e., 2, 14, 15 and 16) was generic to a plurality of disclosed patentably distinct species. Since applicants elected group I, which did not include the last two claims, applicants did not need to make species elections for those claims, and pointed this out to the Examiner.

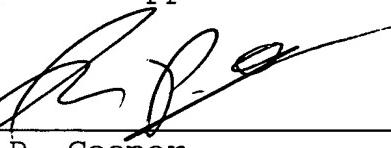
However, the Examiner, in the February 25, 2004 effectively withdrew the group level restriction, searching groups I-IV. While we deeply appreciate this reconsideration, we are concerned with how the Examiner chose to handle the species restrictions for claims "14" (15) and "15" (16). Instead of requiring us to

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make the appropriate species elections, the examiner arbitrarily elected sua sponte the first species recited in each Markush group.

Respectfully submitted,

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